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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,879

02/16/2007

Thomas Chapman

784-115

8434

30448

7590

10/29/2008

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

10/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,879	<b>Applicant(s)</b> CHAPMAN, THOMAS	
	<b>Examiner</b> LEE FINEMAN	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/17/06</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the imaging apparatus (claims 19-21) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 18.
3. The drawings are objected to because in fig. 4 reference number 43 is shown  
as:  
    4  
    3
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The abstract of the disclosure is objected to because legal phraseology (e.g., means).  
Correction is required. See MPEP § 608.01(b).

6. The specification is objected to because the applicant failed to include section headings as required. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

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- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

7. The disclosure is objected to because of the following informalities: on page 7, line 19 "figure 7" should be --figure 6--.

Appropriate correction is required.

### ***Claim Objections***

8. Claims 7-21 are objected to because of the following informalities:

Regarding claim 7 the limitation "the weapon" lacks antecedent basis.

The dependent claims inherit the deficiencies of the claims from which they depend.

Appropriate correction is required.

9. Applicant is further reminded that when cancelling claims, the claims must be listed by only the claim number and status identifier, without presenting the text of the claims.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Avizonis, Jr. US 6,643,969 B1 (henceforth Avizonis).

Regarding claim 1, Avizonis discloses in figs. 5 and 6 a viewing device (1) that includes a main body (3 and 5), a first reflective surface (9), a second reflective surface (7), a means (23) adapted for removably securing said body to a sighting device (LS), wherein the first and second reflected surfaces are contained within the body (fig. 5), the first reflective surface (9) adapted to direct an incoming light beam from a first aperture ( $A_1$ ) to the second reflective surface (7), wherein the first and second reflective surfaces are not positioned parallel to one another (fig. 5), and the second reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (column 4, lines 35-40) relative to the incoming light beam through a second aperture ( $A_3$ ) for viewing by a user (column 4, lines 31-35).

Regarding claim 22, Avizonis discloses a method of viewing around an obstacle (column 4, lines 31-35) including: (a) providing a viewing device (1) that includes a main body (3 and 5), a first reflective surface (9), a second reflective surface (7), a means (23) adapted for removably securing said body to a sighting device (LS), wherein the first and second reflected surfaces are contained within the body (fig. 5), the first reflective surface (9) adapted to direct an incoming light beam from a first aperture ( $A_1$ ) to the second reflective surface (7), wherein the first and second reflective surfaces are not positioned parallel to one another (fig. 5), and the second

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reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (column 4, lines 35-40) relative to the incoming light beam; (b) mounting said viewing device onto a rear most section of the sighting device (figs. 7 and 8); (c) then viewing the reflected light beam through a rear of the body such that a head of a user looking through the viewing device is not substantially inline with the incoming light beam (column 4, lines 31-35).

12. Claims 1 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodo, US 2005/0132631 A1.

Regarding claim 1, Bodo discloses in figs. 1 and 3 a viewing device (12) that includes a main body (16), a first reflective surface (32), a second reflective surface (36), a means (20, 22, 24) adapted for removably securing said body to a sighting device (10), wherein the first and second reflected surfaces are contained within the body (fig. 3), the first reflective surface (32) adapted to direct an incoming light beam from a first aperture (near 10) to the second reflective surface (36), wherein the first and second reflective surfaces are not positioned parallel to one another (fig. 3), and the second reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (56 degrees based upon the discloses angles see page 2, sections [0025]-[0026])) relative to the incoming light beam through a second aperture (at 40) for viewing by a user (page 1, section [0014]).

Regarding claim 22, Bodo discloses a method of viewing around an obstacle (page 1, section [0014]) including: (a) providing a viewing device (12) that includes a main body (16), a first reflective surface (32), a second reflective surface (36), a means (20, 22, 24) adapted for removably securing said body to a sighting device (10), wherein the first and second reflected

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surfaces are contained within the body (fig. 3), the first reflective surface (32) adapted to direct an incoming light beam from a first aperture (near 10) to the second reflective surface (36), wherein the first and second reflective surfaces are not positioned parallel to one another (fig. 3), and the second reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (56 degrees based upon the discloses angles see page 2, sections [0025]-[0026]) relative to the incoming light beam; (b) mounting said viewing device onto a rear most section of the sighting device (via 20, 22, 24); (c) then viewing the reflected light beam through a rear of the body such that a head of a user looking through the viewing device is not substantially inline with the incoming light beam (page 1, section [0014]).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avizonis.

Avizonis further discloses that many other angles may be employed as desired (column 4, lines 37-38), but does not explicitly state that the second reflective surface is positioned to direct the reflected light beam at an angle of between 40 degrees and 55 degrees and more specifically 50 degrees relative to the incoming light beam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the positioning of the second mirror to employ different angles including the claimed 50 degrees, since it has been held



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that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have been motivated to change the positioning of the second mirror to employ different angles for the purpose of to adapt the viewing device to a particular cover situation. In *re* Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) See also In *re* Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

15. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodo.

Regarding claims 2-5, Bodo further discloses wherein the second reflective surface (36) is positioned at an angle of less than 90 degrees relative to a plane perpendicular to the incoming light beam (fig. 3); and wherein the viewing device (12) is removably secured to the rear eyepiece of a conventional sighting device (via 20, 22, 24). Bodo discloses the claimed invention except for the second reflective surface is positioned to direct the reflected light beam at an angle of between 40 degrees and 55 degrees and more specifically 50 degrees relative to the incoming light beam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the positioning of the second mirror to employ different angles including the claimed 50 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have been motivated to change the positioning of the second mirror to employ different angles for the purpose of to adapt the viewing device to a particular cover situation. In *re* Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) See also In *re* Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

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16. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodo in view of Avizonis.

Bodo further discloses wherein the incoming light beam (30) is directed to a side of the weapon (figs. 1 and 3); wherein the viewing device can be readily rotated about the sighting device, to direct the incoming light beam to either side of the weapon (page 2, section [0023]); and wherein the reflective surfaces are mirrors (page 2, sections [0024]-[0026]). Bodo discloses the claimed invention except for wherein the viewing device is removably secured to the rear eyepiece of a conventional sighting device by a friction fit and wherein the means adapted to removably secure the viewing device to a sighting device is a clip adapted to hold the viewing device with positive engagement to the sighting device. Avizonis teaches in figs. 7 and 8 wherein the viewing device is removably secured to the rear eyepiece of a conventional sighting device by a friction fit (see column 4, line 41-column 5, line 11) and wherein the means adapted to removably secure the viewing device to a sighting device is a clip (27') adapted to hold the viewing device with positive engagement to the sighting device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the means for removable securing the viewing device of Bodo to be a clip and friction fit as taught by Avizonis to quickly provide an infinite number of angles/positions for aiming the weapon (Avizonis, column 4, lines 45-48).

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodo in view of Avizonis as applied to claim 10 above and further in view of Fantone, US 5,526,177.

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Bodo in view of Avizonis as applied to claim 10 above disclose the claimed invention except for wherein relay lenses are incorporated into the viewing device to provide eye relief. Fantone teaches in fig. 8 and column 5, lines 51-67 incorporating relay lenses into a viewing unit to maintain a sharp focus when viewing over the longer distance which provides eye relief in that the image is easier to view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add relay lenses to the viewing unit of Bodo in view of Avizonis to maintain a sharp focus of the image (Fantone, column 5, lines 51-67).

18. Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodo in view of Avizonis and Fantone as applied to claim 11 above and further in view of Burke, US 6,311,424 B1.

Bodo in view of Avizonis and Fantone as applied to claim 11 further disclose wherein the body of the viewing device is constructed from high impact resistant material (in at least so far as the material has a higher impact than other materials like glass; and wherein the sighting device (10) is a conventional riflescope (fig. 1). Bodo in view of Avizonis and Fantone as applied to claim 11 above disclose the claimed invention except for wherein the viewing device is connected to a mounting member by a pivot means; wherein the pivot means is offset relative to a longitudinal axis of the sighting device; wherein the pivot means is integrated into the viewing device and the mounting member; wherein the mounting member is adapted to releasably engage a rear eyepiece of a sighting device; and wherein the engagement is by a friction fit. Burke discloses (figs. 2 or 7) a sighting device (2) and a viewing unit (9) wherein the viewing device is connected to a mounting member (4) by a pivot means (7); wherein the pivot means is offset

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relative to a longitudinal axis of the sighting device (figs. 2 or 7); and wherein the pivot means is integrated into the viewing device and the mounting member (figs. 2 or 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the pivot means to the means/mounting means of Bodo in view of Avizonis and Fantone as taught by Burke to be able to conveniently store the viewing unit when aiming directly with the sighting device (Burke, column 12, lines 55-59). It is noted that the mounting means (27' of Avizonis) is already adapted to releasably engage by a friction fit a rear eyepiece of a sighting device.

19. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodo in view of Avizonis, Fantone and Burke as applied to claim 18 above and further in view of Giuffre et al., US 5,054,225 (henceforth Giuffre).

Bodo in view of Avizonis, Fantone and Burke as applied to claim 18 above disclose the claimed invention except for wherein an imaging apparatus can be attached to a rear of the body to capture the reflected light path; wherein the imaging apparatus is a fiber optic cable; and wherein the imaging apparatus is a device that generates video images. Giuffre teaches in figs. 1-4 adding an imaging apparatus (22 or 50) can be attached to a rear of the body to capture the reflected light path; wherein the imaging apparatus is a fiber optic cable (22); and wherein the imaging apparatus is a device that generates video images (50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the imaging apparatus of Giuffre to the viewing device of Bodo in view of Avizonis, Fantone and Burke to be able to aim the device without the need to maintain a constant distance of a head position in relation to the optical portion of the aiming device (Giuffre, column 1, lines 30-35).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE FINEMAN whose telephone number is (571)272-2313. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lee Fineman/  
Examiner, Art Unit 287  
23 October 2008